

## REMARKS

Prior to this response, Claims 1, 4-25 and 35 were pending in the application. No claims are added or cancelled. Hence, Claims 1, 4-25 and 35 are still pending in the application, with Claims 1, 20, 24 and 35 amended herein.

### SUMMARY OF THE REJECTIONS/OBJECTIONS

Claims 1, 20, 24 and 35 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite; Claims 1, 4, 5, 7-9, 11-25 and 35 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Besaw et al. ("*Besaw '789*"; U.S. Pat. No. 5,276,789) in view of Besaw et al. ("*Besaw '897*"; U.S. Pat. Appl. Pub. No. 2002/0158897); and Claims 6, 10 and 35 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Besaw '789* in view of *Besaw '897* and further in view of Nielsen ("*Nielsen*"; U.S. Patent No. 5,937,417).

### THE REJECTION NOT BASED ON THE PRIOR ART

#### Rejection under 35 U.S.C. § 112, second paragraph

Claims 1, 20, 24 and 35 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action appears to contend that these claims are indefinite because the claims do not recite converting the second topology information into a markup language document format before causing display of a graph that includes a second portion of a topology that is based on the second topology information. This rejection is traversed.

Claims 1, 20, 24 and 35 *do* particularly point out and distinctly claim subject matter regarded as respective embodiments of the invention. The respective subject matter regarded as embodiments of the invention is precisely what is recited in these claims. There is no

requirement that an applicant must include in a claim every single step or component that may or may not be performed by an actual implementation of an embodiment of the invention. Therefore, Claims 1, 20, 24 and 35 recite respective embodiments of the invention that are operable, and definite, as currently claimed.

Note that these claims specifically recite, *inter alia*, “causing display of a graph of ... the second portion of the topology based on the second topology information.” Hence, recitation that the second portion of the topology is displayed based on the second topology information conceptually includes displaying the second portion using a markup language form that is based on the second topology information, and is definite. The second topology information *may* be converted to markup language format before being displayed, or *may not* be. Regardless, it is improper and unfair to read limitations into a claim which are not explicitly recited in such claim. Furthermore, examiners are not allowed to define what an applicant regards as an embodiment of the invention by alleging that anything short of what the examiner contends is the invention is indefinite. Generally, Applicants are allowed to claim subject matter as broadly as desired to the extent that the subject matter is not in the prior art.

However, because this application has already undergone lengthy prosecution, Claims 1, 20, 24 and 35 are amended herein in order to expedite a positive disposition of the application. Because such an amendment is not legally necessary, as described above, this amendment is not related to patentability but is submitted solely in order to deter further undue delay in allowance of the application. Hence, prosecution history estoppel under the *Festo* line of cases is inapplicable in this instance.

## THE REJECTIONS BASED ON THE PRIOR ART

### Declaration under 37 C.F.R. §1.131

Filed with the Request for RCE (dated July 5, 2005) and with the previous response (dated March 25, 2005) was a Declaration under 37 C.F.R. §1.131 ("the Declaration"). The Office Action to which this is a response did not indicate any consideration of or disposition of the Declaration. Pursuant to a telephone conversation on August 31, 2005 between Examiner Ms. Good Johnson and applicant's representative Mr. Henkhaus, the Examiner indicated that the Declaration would be considered and a new paper would be issued based on the consideration of the Declaration. **No Supplemental or Corrected Office Action has yet been received**, and private PAIRS does not indicate that such a paper is soon forthcoming. Therefore, this response became necessary at this time in order to avoid payment of extension fees.

It is hereby formally requested that the previously submitted Declaration be fairly and timely considered in the examination of this application. The Declaration and attached Exhibits 1 through 7 were submitted as probative of a reduction to practice of the invention prior to April 30, 2001, which is the filing date of the patent application 09/843,887 that was published as US 2002/0158897 A1 on October 31, 2002 (*Besaw '897*). Hence, the present invention antedates the *Besaw '897* reference. Therefore, the *Besaw '897* reference should be removed from, and not relied upon for, any further grounds for rejection of the present claims.

### Rejections under 35 U.S.C. § 103(a)

#### (I) Claims 1, 4, 5, 7-9, 11-25 and 35

Claims 1, 4, 5, 7-9, 11-25 and 35 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Besaw '789* in view of *Besaw '897*. This rejection is traversed based on the Declaration and Remarks submitted on July 5, 2005.

Based on the Declaration, the *Besaw* '897 reference should be removed as prior art from any further grounds for rejection of all claims in the application and, therefore, no further remarks regarding the cited references of record are presented at this time. However, the rejections of Claims 1, 4, 5, 7-9, 11-25 and 35 are collectively traversed, and no statements of official notice or allegations of well-known features that may be present in the Office Action are stipulated to or admitted as prior art features, and the right to separately argue such features in the future is not disclaimed.

Based on the foregoing, withdrawal of the rejection of Claims 1, 4, 5, 7-9, 11-25 and 35 under 35 U.S.C. § 103, and allowance thereof, is respectfully requested.

(II) Dependent Claims 6 and 10

Claims 6 and 10 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Besaw* '789 in view of *Besaw* '897 and further in view of *Nielsen*. This rejection is traversed based on the Declaration and Remarks submitted on July 5, 2005.

Based on the Declaration, the *Besaw* '897 reference should be removed as prior art from any further grounds for rejection of all claims in the application and, therefore, no further remarks regarding the cited references of record are presented at this time. However, the rejection of Claims 6 and 10 is traversed, and no statements of official notice or allegations of well-known features that may be present in the Office Action are stipulated to or admitted as prior art features, and the right to separately argue such features in the future is not disclaimed.

Based on the foregoing, withdrawal of the rejection of Claims 6 and 10 under 35 U.S.C. § 103, and allowance thereof, is respectfully requested.

CONCLUSION

For at least the reasons indicated above, Applicants submit that all of the pending claims (1, 4-25 and 35) present patentable subject matter over the prior art references of record,

and are in condition for allowance. Therefore, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner has questions regarding this case, the Examiner is encouraged to contact Applicant's undersigned representative.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortages in fees due in connection with the filing of this paper, including extension of time fees, or credit any overages to Deposit Account No. 50-1302.

Respectfully Submitted,

HICKMAN PALERMO TRUONG & BECKER  
LLP

Date: 11/3/05

John D. Henkhaus  
John D. Henkhaus  
Reg. No. 42,656

(408) 414-1080, Ext. 203  
Fax: (408) 414-1076  
2055 Gateway Place, Suite 550  
San Jose, CA 95110-1089

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on 11/3/05 by Darci Sakamoto  
Darci Sakamoto